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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/550,617 | 09/26/2005 | Cheng Hwee You | 743459-23 | 4654 |

22204 7590 04/14/2009

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| EXAMINER | |
|---|---|
| PARKER, BRANDI P | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3624 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 04/14/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/550,617 | YOU, CHENG HWEE | |
| | Examiner | Art Unit | |
| | BRANDI P. PARKER | 3624 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Acknowledgements*

1. The following is a Final Office action in response to communications filed on 1/21/2009. Claims 1 and 24 have been amended.

### *Response to Applicant's Remarks*

2. In response to Applicant's argument that the amendment of claims 1 and 24 obviate any perceived issue of statutory subject matter in the claims, Examiner respectfully disagrees. Whether a method appropriately includes particular machines to qualify as a section 101 process may not always be a straightforward inquiry. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *In re Comiskey*, 499 F.3d 1365, 1380 (Fed. Cir. 2007), (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (BPAI 2008-1495, 2008).

3. Applicant's argument with respect to claims 8-10 and 21 has been fully considered and is persuasive. The rejection of claims 8-10 and 21 under 35 USC § 112 has been withdrawn.

4. In response to Applicant's argument that Tschiegg does not teach determining loss before and after implementation of a recommendation, Examiner respectfully disagrees. Tschiegg discloses a system that can among other things, maintain risk assessment information, including loss prevention measures before the loss of an asset (paragraph 0005) and produces a recommendation regarding the asset. Additionally, paragraph 0019 of Tschiegg measures the loss of the asset after implementation of a recommendation to determine the impact of the loss of said asset. Therefore, Tschiegg does teach and suggest this limitation of claim 1.

5. In response to Applicant's argument that Tschiegg does not teach conducting for each of said zones a respective zone risk assessment, Examiner respectfully disagrees. The filter function in Tschiegg displays data fields containing risk information, the data being derived from the corresponding risk management information (paragraph 0057). The risk management information can be limited to particular zones, for example the risk management information in Tschiegg can be limited to a particular region or zone (paragraph 0069-0070). Therefore Tschiegg does teach and suggest this limitation of claim 1.

6. In response to Applicant's argument that Heinrich does not teach assessing the risk level associated with an asset or assessing the risk level associated with said respective asset independent of the respective zone of said respective asset, Examiner respectfully disagrees. Heinrich discloses focusing on the protection of information

assets (paragraph 0002). Furthermore, Heinrich discloses that the purpose of a risk assessment is to evaluate threats to assets, identify vulnerabilities, determine the relevant risk, and to develop countermeasures to mitigate the risk (paragraph 0015). In Heinrich, the asset involved in the risk assessment is a computer network system (paragraph 0049). Therefore, Heinrich does teach and suggest this limitation in claim 1.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-14 and 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

Claims 1 and 24 are directed towards a method for assessing risk within an organization. As the claims are not sufficiently tied to an apparatus, such as a computer, and/or do not transform the underlying subject matter (from your claim) to a different state, the claimed method is non-statutory and therefore rejected under 35 U.S.C. 101.

10. Claims 2-14 and 24-26 are rejected for being dependent upon rejected claim 1.

***Examiner's Notes***

11. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1, 6, 8, 14, 19, 21 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tschiegg et al (US 2003/0160818) in view of Heinrich (US 2003/0046128).

14. With respect to claims 1 and 16, Tschiegg teaches a computer-implemented method for assessing risk within an organization, comprising:

a. defining one or more zones, each of said one and more zones comprising an environment (paragraph 0009, regarding location identifiers, earthquake zones and flood zones);

b. identifying one or more assets of said organization, each of said assets being located in a respective one of said zones (paragraph 0009, regarding risk management information within the zones, which include company assets; Figure 4. regarding the listed assets in the database);

c. conducting a respective impact assessment for each of said assets, each assessment comprising assessing the impact of the loss of said respective asset

(paragraph 0019, regarding determining loss before and after implementation of recommendation);

d. conducting for each of said zones a respective zone risk assessment, comprising (paragraph 0058-0069, regarding the filter function that allows for customized reporting about specific risk management segments);

e. conducting for each asset a respective asset risk assessment (paragraph 0009-0010, regarding risk management and reporting functions); and

f. assessing risk on the basis of at least said impact assessment, said zone risk assessment and said asset risk assessments (paragraph 0009-0010, regarding risk management and reporting functions).

Tschiegg does not explicitly teach assessing a risk level of the asset within a zone. However, Heinrich teaches

g. assessing the risk level associated with an asset (paragraph 0036); and

h. assessing the risk level associated with said respective asset independent of the respective zone of said respective asset (paragraph 0037).

It would have been obvious to one of ordinary skill in the art to include the business system of Tschiegg with the ability to assessing a risk level of the asset as taught by Heinrich since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

15. As to claims 6 and 19, Tschiegg further teaches maintaining a register of said zones (paragraph 0009, regarding database of location and zone information).

16. Regarding claims 8 and 21, Heinrich further teaches wherein each of said assets is information related (0049, regarding risk assessment of a computer network system).

17. Regarding claims 14 and 23, Heinrich further teaches including determining a measured risk for each asset, said measured risk for a respective asset comprising the product of 1) an impact level determined in said impact assessment and 2) the maximum of an asset risk determined in said asset risk assessment and an asset risk determined in said zone risk assessment (paragraph 0045-0048, regarding associating asset risk to risk levels and conducting a risk assessment).

18. With respect to claim 24, Tschiegg further teaches a risk management method, comprising managing said risk (paragraph 0003, regarding managing risk).

19. As to claim 25, Heinrich further teaches wherein said managing of said risk comprises:

i. determining the distribution of the number of assets as a function of associated measured risk (paragraph 0045, regarding assigning value to each risk to calculate an overall risk);

j. determining a maximum acceptable risk level (paragraph 0048, regarding upper limit of the risk severity); and

k. applying one or more controls if any of said assets exceeds said maximum acceptable risk level (paragraph 0168, regarding implementing changes to eliminate or downgrade risks).

20. Regarding claim 26, Heinrich further teaches wherein said acceptable risk level comprises the lower of the highest available measured risk or 100% (paragraph 0058).

21. Claims 2-5, 7, 9-13, 15, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tschiegg et al (US 2003/0160818) and Heinrich (US 2003/0046128) in further view of Lovejoy et al (US 2002/0138416).

22. Regarding claims 2 and 17, Tschiegg in view of Heinrich teaches a method as claimed in claim 1. Tschiegg in view of Heinrich does not directly teach identifying asset custodians. However, Lovejoy teaches identifying one or more asset custodians, each comprising a custodian of a respective asset, and identifying one or more of said assets (paragraph 0056 and 0060, regarding the category of users that inventory the assets).

It would have been obvious to one of ordinary skill in the art to include the business system of Tschiegg and Heinrich with the ability to identify asset custodians as taught by Lovejoy since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

23. As to claim 3, Lovejoy further teaches wherein each of said custodians is an employee with care-taking responsibilities (paragraph 0056 and 0060, regarding the category of users that inventory the assets).

24. With respect to claim 4, Lovejoy further teaches including maintaining a register of said assets (paragraph 0055, regarding the inventory of assets stored in a database).

25. Regarding claim 5, Lovejoy further teaches wherein said register includes a respective owner of each of said assets (paragraph 0056 and 0060, regarding the category of users that inventory the assets; also see page 20 of applicant's specification where custodians can also be owners).

26. As to claims 7 and 20, Lovejoy further teaches the register of zones as taught by Tschiegg including a respective custodian of each of said zones (paragraph 0056 and 0060, regarding the category of users that inventory the assets).

27. With respect to claim 9, Tschiegg in view of Heinrich teaches a method as claimed in claim 2 wherein each of said assets is information related. Lovejoy further teaches where each of said asset custodians is an information custodian, each comprising a custodian of a respective information storage device within said organization (paragraph 0056 and 0060, regarding the category of users that inventory the assets).

28. As to claim 10, Lovejoy defines custodians including users, risk assessor, security practitioner (physical and environmental custodian) and system administrators (MIS support custodian) (paragraph 0056). Lovejoy does not directly teach network

custodians or software engineering custodians. However, the simple substitution of one known element for another producing a predictable result renders the claim obvious. Therefore, it would have been obvious to one with ordinary skill in the art to add additional network custodians and software engineering custodians to the system in Lovejoy.

29. Regarding claims 11 and 12, whether the zone assessment is conducted by the respective custodian or owner of said respective zone is representative of descriptive material that does not modify the functionality of the underlying method to distinguish the claimed invention from the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). Therefore, it would have been obvious to one with ordinary skill in the art to have the custodian or owner of the asset conduct the zone assessment.

30. As to claims 13 and 22, Lovejoy further teaches regarding the loss of an asset as equivalent to the loss of a system of which said asset is a part (paragraph 0063, compromised assets causing a loss to the organization).

31. With respect to claim 15, Lovejoy further teaches wherein none of said custodians is an owner (paragraph 0056 and 0060, regarding the category of users that inventory the assets).

***Conclusion***

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley B. Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRANDI P PARKER/
Examiner, Art Unit 3624

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624